

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1, 3-6, 11 and 23 are pending in the present application. Claims 2, 7-10, 12-22 and 24-25 have been canceled.

In the outstanding Official Action, the specification was objected to for not referring to the updated status of patent application No. 10/088,965. As suggested by the Examiner, the specification has been amended to indicate that United States patent application No. 10/088,965, filed on July 25, 2002 is now U.S. Patent No. 6,734,292.

Claims 23-25 were rejected under 35 USC 112, first paragraph, for allegedly not satisfying the written description requirement. Applicants believe that the present amendment obviates this rejection.

While applicants acknowledge that the specification does not specifically recite the phrase "method for the differentiation-induction of a monocyte to a macrophage in a patient", applicants believe that the terminology is implicit from the overall teaching of the present disclosure. In particular, the Examiner's attention is respectfully directed to page 6, where results of the enhancing effect for differentiation-induction from human monocyte to macrophages is provided. Nevertheless, in the interest of advancing

prosecution, claim 23 has been amended to recite a method for the differentiation-induction of a monocyte to a macrophage. As a result, applicants believe that claim 23 is supported by the present disclosure.

Claims 1, 8-10 and 23 were rejected under 35 USC 112, first paragraph, for allegedly not satisfying the enablement requirements. Applicants believe that the present amendment obviates this rejection.

In imposing the rejection, the Official Action alleged that the term "substituents" is not supported by the present disclosure. Nevertheless, in the interest of advancing prosecution, the claims have been amended so that this terminology is no longer recited.

Claims 1 and 8-23 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants believe that the present amendment obviates this rejection.

Claim 1 was rejected for reciting the phrase "wherein  $R_1$  is Me or I-Pr,  $R_2$  is not H". However, as suggested by the Examiner, the phrase has been amended to recite that "wherein when  $R_1$  is Me or i-Pr,  $R_2$  is not H".

Claims 1 and 23 were rejected for reciting the term "substituents". However, as noted above, this term is no longer recited in the claims.

In the outstanding Official Action, claims 1 and 8-10 were alleged to be substantial duplicates of each other. Moreover, claims 11-14; claims 15-18; and claims 19-22 were also found to be substantial duplicates of each other, respectively. In the interest of advancing prosecution, claims 8-10 and 12-22 have been canceled.

In the outstanding Official Action, claims 1-22 were rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-30 of U.S. Patent No. 6,734,292. Applicants believe that the present amendment obviates this rejection.

At this time, the Examiner's attention is respectfully directed to the Terminal Disclaimer directed to U.S. Patent No. 6,734,292. As a result, applicants believe that the rejections of claims 1-22 under the judicially-created doctrine of obviousness-type double patenting has been obviated.

In the outstanding Official Action, claims 11, 15-19 were also rejected under the grounds of statutory double patenting. However, as noted above, claims 15-19 have been canceled. As to claim 11, claim 11 has been amended to recite that "wherein R<sub>3</sub> is NOH, and Me indicates methyl". As a result, applicants believe that claim 11 is not identical to claim 22 of United States Patent No. 6,734,292. Thus, applicants request that the rejection be withdrawn.

Claims 1-14 and 23-25 were rejected under 35 USC 102(b) as allegedly being anticipated by HOELTJE et al., KIRST et al. or GIDDA et al. Applicants believe that the present amendment obviates these rejections.

In the present application, claims 1, 11 and 23 are independent claims. Claim 1 has been amended to recite that "wherein  $R_1$  is H or Me,  $R_2$  is not H, Me, or i-Pr". Claim 11 has been amended to recite that "wherein  $R_3$  is NOH, and Me indicates methyl". As a result, applicants believe that HOELTJE et al., KIRST et al. and GIDDA et al. each fail to anticipate the claimed invention.

As to claim 23, claim 23 is directed to a method for differentiation-induction of a monocyte to a macrophage, comprising treating said monocyte with an effective amount of a pseudoerythromycin derivative represented by formula [I] of the present invention. HOELTJE et al., KIRST et al. and GIDDA et al. all fail to disclose or suggest a method for the differentiation-induction of a monocyte to a macrophage. As a result, applicants believe that the publications fail to anticipate claim 23.

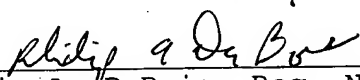
In view of the present amendment and the foregoing Remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

Please charge the fee of \$130 for the Terminal Disclaimer filed herewith, to Deposit Account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

  
Philip A. DuBois, Reg. No. 50,696  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

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**APPENDIX:**

The Appendix includes the following item(s):

- ☒ - a terminal disclaimer
- ☐ - a 37 CFR 1.132 Declaration
- ☐ - a new or amended Abstract of the Disclosure
- ☐ - a Replacement Sheet for Figure                      of the drawings
- ☐ - a Substitute Specification and a marked-up copy of the  
originally-filed specification
- ☐ - a verified English translation of foreign priority document